

6-17-04

IFW DAE



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Nolan, et al.

Serial No.: 09/342,024

Filed: 28 June 1999

For: HIGH EFFICIENCY TRANSFECTION  
BASED ON LOW ELECTRIC FIELD  
STRENGTH, LONG PULSE LENGTH

Examiner: Leffers, Gerald G.

Art Unit: 1636

**PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT UNDER 37 C.F.R. 1.181(a) OR,  
IN THE ALTERNATIVE, PETITION TO REVIVE UNDER 37 C.F.R. 1.137**

Commissioner For Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450  
Attention: Mail Stop PETITION

Sir:

Applicants herein petition for withdrawal of the holding of abandonment under 37 C.F.R. 1.181(a) or, in the alternative, to revive the captioned patent application under 37 C.F.R. 1.37 (a) as a result of failing to respond to a Notice of Improper Request for Continued Prosecution allegedly mailed 23 October 2003 in response to Applicants' Request for Continued Prosecution submitted on 29 September 2003 in response to the 01 April 2003 Office action. Please find included with this petition:

- (1) a statement regarding the reason why the holding of abandonment should be withdrawn or, in the alternative, why the delay was unavoidable;
- (2) a terminal disclaimer;
- (3) a continuation application which constitutes a reply to the outstanding Office communications; and
- (4) if necessary, a check the amount of \$110 for the sum of the small entity fee due in connection with reviving an unavoidably abandoned application and a small entity terminal disclaimer fee, in addition to a credit card authorization to charge such additional fees as may be required in connection with this submission and the accompanying continuation application.

**CERTIFICATE OF EXPRESS MAILING  
(37 CFR 1.10)**

I hereby certify that this paper (along with anything referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below via the U.S. Postal Service's "Express Mail - Post Office to Addressee" service with label no. ED032443107 US addressed to: Mail Stop PETITION, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

15 June 2004

Date of Deposit

Daniel M. Chambers

**STATEMENT TO THE COMMISSIONER**

Applicants hereby petition the Commissioner to withdraw the holding of abandonment in this application or, in the alternative, to revive this patent application due to the failure to respond to the Notice of Improper Request for Continued Prosecution that allegedly was mailed 23 October 2003 in response to Applicants' Request for Continued Prosecution submitted on 29 September 2003 in response to the 01 April 2003 Office action.

The events referred to above have occurred as a result of confusion surrounding Applicants' efforts to fully respond to the 01 April 03 Office action by way of submission of a Request for Continued Prosecution (and a petition with fee for a three-month extension) on 29 September 2003 pursuant to a recommendation set forth on page 7 of the 01 April 03 Office action. Applicants now understand that due to a rule change introduced by the Office after the mailing of the 01 April 03 Office action but prior to submitting their Request for Continued Prosecution, that Request was deemed improper, notice of which was allegedly mailed on 23 October 2003. Neither Applicants nor their attorney of record during the period at issue (i.e., the undersigned), however, ever received the 23 October 2003 Notice of Improper Request for Continued Prosecution. Applicants' undersigned attorney confirmed the non-receipt of that Notice by searching the file wrapper and reviewing the docket for this case (an up-to-date copy of which is attached hereto as Exhibit A). Because Applicants never received the Notice of Improper Request for Continued Prosecution, they were unable to respond to it, and it was apparently this lack of response that has resulted in the case becoming, or at least being held, abandoned, as indicated by the Notice of Abandonment mailed on 17 February 2004. Applicants respectfully submit that the entire delay in responding to the 23 October 2003 Notice was unavoidable because that Notice was never received.

To overcome the holding of abandonment or, alternatively, the actual but unavoidable abandonment of this application, in support of this petition Applicants have included herewith a continuation application that claims priority to this application. Applicants respectfully request that the fees paid previously in connection with the CPA filing that was deemed improper be applied to the accompanying continuation application.

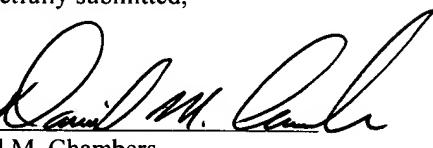
Finally, because this petition is being filed later than 17 April 2004, Applicants kindly request that the Office consider this matter on its merits. As required, Applicants have also enclosed a terminal disclaimer dedicating to the public the terminal part of the term of any patent granted on this application or a related application (e.g., the accompanying continuation application) that may extend the lesser of (a) the period of abandonment or (b) the period beyond 20 years from the earliest applicable priority date.

In light of the above circumstances and the accompanying continuing application and terminal disclaimer, Applicants respectfully petition for withdrawal of the holding of abandonment. Alternatively, in the event the Office determines that the instant application indeed went abandoned, Applicants hereby petition to have the application revived under 37 C.F.R. 1.37(a) for a period sufficient to result in a period of co-pendency with the accompanying continuation application.

**CONCLUSION**

Should any issues or questions arise during consideration of this request, or if additional information is required, the officer considering this petition is encouraged to telephone the undersigned at 858.350.9690 so that they may be promptly resolved.

Respectfully submitted,

By:   
Daniel M. Chambers  
Attorney for Applicants  
Reg. No. 34,561  
BioTechnology Law Group  
658 Marsolan Ave.  
Solana Beach, CA 92075  
Tel: 858.350.9690  
Fax: 858.350.9691

Dated: 15 June 2004

USSN: 09/342,024

GTI 1120 CIP1

**Exhibit A**

Docket report – 2 pages attached)

**BioTechnology Law Group**  
**Case History Report**  
**Gentronics: SN/ 09/342,024**

Date: June 14, 2004

Date Due	Done	Who	What	Case No	Inventor	Case Title
6/28/1999	DMC	Application Filing	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length	
8/28/1999	Received	DMC	Filing Postcard	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
8/30/1999	1/26/2000	DMC	Assignment Filing	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
8/30/1999	2/22/2002	DMC	Information Disclosure Statement	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
9/27/1999	1/28/2000	DMC	Additional Signatures/Filing Fee	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
9/28/1999	7/30/1999	DMC	Filing Receipt	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
3/26/2000	Received	DMC	Additional Signatures Postcard	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
3/26/2000	2/8/2000	DMC	Assignment Recording	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
3/26/2000	Received	DMC	Assignment Postcard	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
10/2/2001	10/2/2001	DMC	Office Action Mailed - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
4/2/2002	4/2/2002	DMC	Last Date To File Office Action Response - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
4/8/2002	Received	DMC	Postcard (Resp to OA) - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
4/22/2002	Received	DMC	IDS Postcard - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
6/19/2002	6/19/2002	DMC	Final Office Action Mailed - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
12/19/2002	12/19/2002	DMC	Respond to Final Office Action - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
2/19/2003	Received	DMC	Office Action Postcard - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
4/1/2003	4/1/2003	DMC	Office Action Mailed - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
7/1/2003	9/29/2003	DMC	Respond to Office Action - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length

**BioTechnology Law Group  
Case History Report  
Gentronics: SN/ 09/342,024**

Date: June 14, 2004

Date Due	Done	Who	What	Case No	Inventor	Case Title
7/19/2003	7/21/2003	DMC	5th EOT to file Appeal Brief is 7/19/03 NXT - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
8/19/2003	8/19/2003	DMC	8/16/03-OA dated 4/1/03 recd from DMC-APPLN IS IN APPEAL STAGE - 4/1 OA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
10/1/2003	9/23/03	DMC	CPA FILED 9/29/03 - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
11/29/2003	Received	DMC	Office Action Postcard - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length
2/25/2004		DMC	2/17/04 Notice of Abandonment for failure to reply to 4/1/03 OA - USA	GTI-1120-CIP1	Nolan	High Efficiency Transfection Based on Low Electric Field Strength, Long Pulse Length